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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,973	10/29/2001	James H. Bennett	7190-D20	3960
7590	07/13/2004		EXAMINER	
BASF CORPORATION PATENT DEPARTMENT 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/052,973	JAMES H. BENNETT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 April 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 34-44 and 46-53 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 34-44 and 46-53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

The previous rejections are withdrawn due to Applicant's amendments. Cancellation of claims 1-33 and 45 are acknowledged.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 34-36, 38-44, and 47-53 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,040,210 to Charlton et al.

Charlton teaches a decorative surface covering and the process of making the covering. Pieces or chips (equivalent to particles) of a linoleum mixture (11) are in multi-colors or contrasting colors and extruded into a sheet (31). The mixture 11 comprises resinous binders, pigments and fillers such as whiting clay (a colorant mixture). See col. 2, line 42-col. 3, line 45, col. 3, line 55-70, and the Figure. Various colors are provided such as black and white pigments that are mixed together as well as many other colors to form pieces, chips, or granules at col. 3, lines 55-75, thereby producing the thermoplastic resin system including a color and colorant mixture as per instant claims. The color mix produces a visual effect such as the color of granite as explained above. See col. 2, lines 4-10. The color sheet (31) is pressed directly on and compressed into an additional linoleum sheet (37) by pressure rolls (35) and (36). Sheet 31 bonds to sheet 37 by pressure (instant claim 43). The same thermoplastic/elastomeric

v vinyl chloride polymers of instant claims 39-42, 47-50, and 52-53 are also provided at col. 3, lines 25-34 as suitable resinous binders for linoleum.

Applicant's arguments have indicated that "consisting essentially of" would exclude an adhesive, that would materially affect applicant's invention. Since no adhesive is present in the Charlton reference, the claims are again construed as open or that of "comprising" language.

That the thermoplastic layer is extruded is not afforded patentable weight as such limitation is process derived. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,040,210 to Charlton et al. in view of USPN 5,358,993 to Timm et al.

5. Charlton essentially teaches the claimed invention above. Charlton does not expressly disclose a US Mesh size from -10 to about +5000 as instant claims 37 and 46. However, Timm teaches an inlaid granite plastic floor tile of polyvinyl chloride as the support with a chip formula within the size of 10 to 200 and -14 to +25 US mesh size, which falls within Applicant's range of -10 to about +5000 (col. 2, lines 35-65). It would have been obvious to one of ordinary skill in the art to modify the covering of Charlton to include chip sizes between -10 and +5000 because Timm teaches the conventionality of using these specific sizes for inlaid tiles (col. 2, lines 35-65).

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6221462 to Graab et al. teaches a multicolored patterned layer on a thermoplastic sheet. USPN 4863782 to Wang et al. teaches inlaid patterns for producing a 3-D effect on a thermoplastic sheet. USPN 4,956,030 to Baskin teaches a simulated stone over a plastic foam sheet.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1774

Tamra L. Dicus  
Examiner  
Art Unit 1774

July 8, 2004

  
RENA DYE  
PRIMARY EXAMINER  
A.U. 1774